

### **REMARKS**

Applicant hereby traverses the rejections of record and requests reconsideration and withdrawal of such in view of the remarks contained herein. Claims 1-5, 7, 9, 10, 19, and 20 remain pending in this application

#### **Rejection Under 35 U.S.C. § 102(b) (Ishinaga)**

Claims 1, 3, 5, 7, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,355,946 to Ishinaga (hereinafter "Ishinaga").

It is well settled that to anticipate a claim, the reference must teach every element of the claim. *see* M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim." *see* M.P.E.P. § 2131; citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *see* M.P.E.P. § 2131; citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989).

Claim 1 recites "a molded encapsulation layer...wherein said molded encapsulation layer is shaped to direct light emitted by said emitter such that the molded encapsulation layer reduces a difference in beam divergence between a fast-axis and a slow-axis of said emitter." In the Current Action, the Examiner points to Ishinaga at Fig. 2, and opines that an elliptically shaped cup [of Inshinaga] satisfies this element. (*see* Current Action, paragraphs 2 & 5). Specifically, the Examiner states "the molded encapsulation layer (50) is elliptical since the cup in which it is formed is elliptical; therefore Ishinaga meets this limitation." *Id.* Applicant respectfully submits that Inshinaga does not teach this claim element. Rather, Inshinaga describes an "elongated transverse section, which may be oblong, elliptical, rhombic, or rectangular." (Inshinaga, col. 2, lines 24-26). Inshinaga also provides that an "inner wall surface gives an elliptical appearance, while as viewed in two vertical sections intersecting at right angles, it gives an appearance of a quadric curve." (Inshinaga, col. 4, lines 36-40). Moreover, the oblong or elliptical elongated transverse section, as provided by Ishinaga, has an exterior surface forming a planar surface in combination with casing 52. (Ishinaga, figs. 3-5). The Applicant submits that the oblong or

elliptical elongated transverse section, which forms a planar surface with an outer casing, is not the same as a molded encapsulation layer shaped to direct light such that the molded encapsulation layer reduces a difference in beam divergence between a fast-axis and a slow-axis as required by claim 1. Therefore, the Applicant respectfully requests that the 35 U.S.C. § 102(b) rejection of record be withdrawn.

In the Current Action, the Examiner opines that Applicant has not shown “structural difference” between applicant’s claimed invention and the cited reference to show a “molded encapsulation layer [that] reduces difference in beam divergent between a fast axis and a slow-axis.” *See* Current Action, paragraph 2. Also, the Examiner states that the “prior art is capable of performing the intended use.” *Id.* Applicant respectfully directs the Examiner to paragraph [0016], which reads in part: “...embodiments enable an elliptical lens in the encapsulation layer to partially compensate for the difference in divergence in the two [fast and slow] axes. Specifically, the radius of curvature associated with the fast-axis may be greater than the radius of the curvature associated with the slow axis thereby causing the difference in the divergence to be reduced.” Applicant submits that Ishinaga is not capable of “performing the intended use.” Applicant reminds the Examiner that Ishinaga discloses the appearance of a quadric curve.” (Inshinaga, col. 4, lines 36-40). Moreover, the oblong or elliptical elongated transverse section, as provided by Ishinaga, has an exterior surface forming a planar surface in combination with casing 52. (Ishinaga, figs. 3-5). In view of Ishinaga’s structural limitations, it cannot perform reducing a difference in beam divergence between a fast-axis and a slow-axis of said emitter. (*also see* Ishinaga, at Figs. 3-5).

Claims 3, 5, 7, and 9 depend from base claim 1, and thus inherit all limitations of claim 1. Each of claims 3, 5, 7, and 9 set forth features and limitations not recited by Inshinaga. Thus, the Applicant respectfully asserts that, for at least the reasons set forth above with respect to claim 1, claims 3, 5, 7, and 9 are patentable over the 35 U.S.C. § 102(b) rejection of record.

**Rejection Under 35 U.S.C. § 102(e) (Matsubara)**

Claims 1, 2, 3, 5, 7, 9, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,642,547 to Matsubara et al (hereinafter “Matsubara”).

It is well settled that to anticipate a claim, the reference must teach every element of the claim. *see* M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim.” *see* M.P.E.P. § 2131; citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *see* M.P.E.P. § 2131; citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989).

Claim 1 recites “a molded encapsulation layer...wherein said molded encapsulation layer is shaped to direct light emitted by said emitter such that the molded encapsulation layer reduces a difference in beam divergence between a fast-axis and a slow-axis of said emitter.” In the Current Action, the Examiner opines that “the difference in beam divergence between the fast-axis and slow-axis is reduced since Matsubara makes it clear that light parallel to the substrate surface (3), or in the slow-axis direction, is radiated (3) perpendicular to the substrate surface, or in the fast-axis direction due to the cup (column 8, lines 4-10).” (Current Action, paragraph 12). The Applicant submits that Matsubara does not teach this claim element. Rather, at column 8, lines 4-10, Matsubara merely describes a reflector 8 that reflects the substrate’s fluorescence in the direction parallel to the LED surface...whereby the directivity of the fluorescence light has been varied significantly.” (Matsubara col. 8, lines 5-10). The Applicant respectfully points out that varying the directivity of light by use of a reflector is not the same as a molded encapsulation layer shaped to direct light such that the molded encapsulation layer reduces a difference in beam divergence between a fast-axis and a slow-axis as recited in claim 1. Therefore, the Applicant respectfully requests that the 35 U.S.C. § 102(e) rejection of record be withdrawn.

Claims 2, 3, 5, 7, and 9 depend from base claim 1, and thus inherit all limitations of claim 1. Each of claims 2, 3, 5, 7, and 9 set forth features and limitations not recited by Inshinaga. Thus, the Applicant respectfully asserts that, for at least the reasons set forth above with respect to claim 1, claims 2, 3, 5, 7, and 9 are patentable over the 35 U.S.C. § 102(e) rejection of record.

**Rejection Under 35 U.S.C. § 103(a) (Ishinaga & Fukasawa)**

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishinaga in view of Fukasawa.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding that the first or second criteria are satisfied, the Applicant respectfully asserts that the Examiner's rejection fails to satisfy the third criteria.

Claim 4, which depends from claim 1, requires a molded encapsulation layer shaped to direct light such that the molded encapsulation layer reduces a difference in beam divergence between a fast-axis. As shown above, Ishinaga fails to teach or suggest this claim limitation. Moreover, the Examiner does not rely upon Fukasawa to teach or suggest this claim limitation. As such, the Examiner's proposed combination fails to teach or suggest each claim limitation of Applicant's invention. Therefore, the Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of record be removed.

**Rejection Under 35 U.S.C. § 103(a) (Matsubara & Fukasawa)**

Claims 4, 19, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishinaga in view of Fukasawa.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding that the first or second criteria is satisfied, the Applicant respectfully asserts that the Examiner's rejection fails to satisfy the third criteria.

Claim 4, which depends from claim 1, requires a molded encapsulation layer shaped to direct light such that the molded encapsulation layer reduces a difference in beam divergence between a fast-axis. As shown above, Matsubara fails to teach or suggest this claim limitation. Moreover, the Examiner does not rely upon Fukasawa to teach or suggest this claim limitation. As such, the Examiner's proposed combination fails to teach or suggest each claim limitation of Applicant's invention. Therefore, the Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of record be removed.

Claim 19 requires a molded encapsulation layer shaped to direct light such that the molded encapsulation layer reduces a difference in beam divergence between a fast-axis. As shown above, Matsubara fails to teach or suggest this claim limitation. Moreover, the Examiner does not rely upon Fukasawa to teach or suggest this claim limitation. As such, the Examiner's proposed combination fails to teach or suggest each claim limitation of Applicant's invention. Therefore, the Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of record be removed.

Claim 20 depends from base claim 19, and thus inherits all limitations of claim 19. Claim 20 sets forth features and limitations not taught or suggested by the combination of Matsubara and Fukasawa. Thus, the Applicant respectfully asserts that, for at least the reasons set forth above with respect to claim 19, claim 20 is patentable over the 35 U.S.C. § 103(a) rejection of record.

**Conclusion**

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-3718, under Order No. 70020976-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail, Airbill No. EV568255104US in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: March 28, 2006

Typed Name: Laura Horton

Signature: Laura Horton

Respectfully submitted,

By Jody C. Bishop  
Jody C. Bishop  
Reg. No.: 44,034  
Date: March 28, 2006  
Telephone No. (214) 855-8007